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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,577

08/22/2005

Klaus Godl

JCLA 16061

8370

7590

07/28/2006

J.C. Patents
Suite 250
4 Venture,
Irvine, CA 92618

EXAMINER

KHANNA, HEMANT

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/523,577

Applicant(s)

GODL ET AL.

Examiner

Hemant Khanna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 51-89 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula I.

Group II, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula IIa and IIb.

Group III, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula IIIa and IIIb.

Group IV, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula IV.

Group V, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula V.

Group VI, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula VI.

Group VII, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula VII.

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Group VIII, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula VIII.

Group IX, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula IX.

Group X, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula X.

Group XI, claim(s) 51-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula XI.

Group XII, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula I.

Group XIII, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula IIa and IIb.

Group XIV, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula IIIa and IIIb.

Group XV, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula IV.

Group XVI, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula V.

Group XVII, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula VI.

Group XVIII, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula VII.

Group XIX, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula VIII.

Group XX, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula IX.

Group XXI, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula X.

Group XXII, claim(s) 59-71, drawn to a method of purifying at least one ATP binding protein comprising the steps of immobilizing one compound of general formula XI.

Group XXIII, claim(s) 76-80, drawn to a method of making a quinazoline compound of general formula (O).

Group XXIV, claim(s) 81-89, drawn to a method a pyrimidine compound of general formula (ε).

2. The inventions listed as Groups I-XXIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the compounds represented by the general formula I-XI disclosed in the independent claim 51 share a common property, that is separating at least one ATP binding protein from a pool of proteins. However, compounds represented by the general formula I-XI do not share a significant structural element that is essential to the common property. Since both the requirements are not met, the group of compounds represented by general formula I-XI do not meet the requirement of unity of invention (*a priori*). Additionally, based on their ring size, whether the rings are isolated or fused and on the number of hetero atoms present, the compounds of general formula I-XI, in fact, represent a plurality of classes namely A-K. Because the classes are distinct, the compounds within those classes must be restricted to different groups as represented by Groups I-XI.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Compounds of the general formula I-XI in claim 51, and other combinations of ring substituents not specifically recited in the claims.

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the unity of invention is lacking *a priori* because compounds represented by the general formula I-XI do not share a significant structural element that is essential to their common property.

Applicant is required, in reply to this action, to elect a single inventive group I-XXIV, and elect a completely defined single general formula I-XI defined by that group i.e. ring substituents namely "R₁", "R₂", "R₃", "X", "Y", "Z", "L", "M", and "N" encompassed by the general formula of the elected group must be defined specifically, to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Notice of Possible Rejoinder

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**

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in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Khanna whose telephone number is (571) 272-9045. The examiner can normally be reached on Monday through Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hemant Khanna


ANISH GUPTA
PRIMARY EXAMINER

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